



AF  
3625

PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/536,377-Conf. #4889	
	Filing Date	March 28, 2000	
	First Named Inventor	Douglas Clark	
	Art Unit	3625	
	Examiner Name	T. Forest	
Total Number of Pages in This Submission	1	Attorney Docket Number	M3653.0001/P001-C

**ENCLOSURES (Check all that apply)**

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):		
<table border="1"><tr><td>Remarks</td><td>Appellant's Reply Brief (in triplicate)</td></tr></table>			Remarks	Appellant's Reply Brief (in triplicate)
Remarks	Appellant's Reply Brief (in triplicate)			

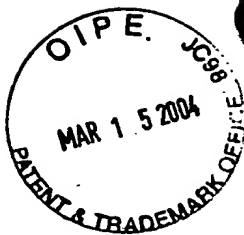
**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP Jon D. Grossman
Signature	
Date	March 15, 2004

**RECEIVED**

**MAR 17 2004**

**GROUP 3600**



# 18  
02  
3/22/04

Docket No.: M3653.0001/P001-C  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Douglas Clark

Application No.: 09/536,377

Confirmation No.: 4889

Filed: March 28, 2000

Art Unit: 3625

For: METHOD AND APPARATUS FOR  
PLANNING AND MONITORING  
MULTIPLE TASKS BASED ON USER  
DEFINED CRITERIA AND PREDICTIVE  
ABILITY AND FOR AUTOMATICALLY  
DETECTING TASK RELATED WORK

Examiner: Forest Thompson, Jr.

**APPELLANT'S REPLY BRIEF**

**Attention: Board of Patent Appeals and Interferences**  
Commissioner for Patents  
Washington, DC 20231

Dear Sir:

Pursuant to 35 U.S.C. § 134 and 37 C.F.R. 1.103 and in response to the  
Examiner's Answer dated January 13, 2004, Appellants hereby submit in triplicate this  
Reply Brief.

I. **REBUTTAL STATEMENTS**

As pages 2-13 of the Examiner's Answer constitutes a restatement of the final  
rejection, Appellants present the following statements in rebuttal to the arguments  
presented in section 11, entitled "Response to Argument," found at pages 14-24 therein.

**RECEIVED**  
**MAR 17 2004**  
**GROUP 3600**

A. THE INTERPRETATION OF THE CLAIM TERMINOLOGY IN THE EXAMINER'S ANSWER IS INCONSISTENT WITH APPELLANT'S INVENTION.

Central to the issue of patentability in the present application is the definition of certain terms defined in Appellants' specification. The terms at issue include, *inter alia*, "tasking horizon," "verbs," "churn" and "risk factor." When construed in the manner described in Appellants' specification and in the Appeal Brief filed on January 26, 2004, one of ordinary skill in the art would readily recognize the claimed invention as being significantly different and patentably distinguishable over Duncan and Levinson, the cited references. The final Office Action and the Examiner's Answer, however, have distorted the true meanings of those terms in an attempt to justify the preconceived conclusion of obviousness based on the disclosures of Duncan and Levinson.

A long standing, fundamental principle in patent law recognizes that applicants have the right to be their own lexicographers, and that generally, the applicant's meanings are binding. *See, e.g., Int'l Cork Co. v. New Process Cork Co.*, 6 F.2d 420, 422 (2d Cir. 1925) (holding that "[a] patentee may define his own terms, regardless of common or technical meaning, and fairness to the patentee requires the court to accept his definition of the words, phrases, and terms."); *accord., Esnault-Pelterie v. Chance Vought Corp.*, 56 F.2d 393, 406-407, 12 U.S.P.Q. 397 (E.D.N.Y. 1932). Thus, where an applicant or patentee has set forth definitions for claim terminology in the specification, the meanings are determined by the applicant or the patentee, not the Examiner. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889, 221 U.S.P.Q. 1025, 1031 (Fed. Cir. 1984) (stating that [i]t is the inventor applying for a patent who is permitted to be his own lexicographer.") (emphasis added). *See also* MPEP §§ 2111.01, 2173.01, 2173.05(a).

In view of this long-standing principle of patent law, an Examiner is not allowed to change the meaning of an applicant's terms as he sees fit in order to force a

construction of a prior art reference into meeting the redefined claims. In this case, the final Office Action and Examiner's Answer misconstrue the "definitions" of the terms "tasking horizon," "verbs," "risk factor," and "churn" in a manner which is inconsistent with the claimed invention, and indeed, would render the claimed invention inoperative.

1. Tasking Horizon

In the bottom half of page 14, the Examiner's Answer cites passages from Appellant's specification relevant to the term "tasking horizon," and then states that the "Examiner interprets this to be synonymous with *planned end of task date* or *planned task completion date*." (Examiner's Answer, page 15, emphasis in original). The Examiner's interpretation is incorrect in the context of the claimed invention as described in Appellant's specification.

While not identically worded, the three passages cited at the bottom of page 14 in the Examiner's Answer each describe the concept embodied by the term "tasking horizon." Specifically, Appellant's specification, when read and interpreted as a whole, reveals that a "tasking horizon" is a time window selected by a project manager, wherein the length of time encompassed by the selected time window remains fixed through the entire duration of the project. (e.g., specification, p. 6, lns. 8-12; p. 11, last 2 lines through page 12, ln. 6). The project is thus managed and monitored one "tasking horizon" at a time, until the project is completed. Defined mathematically, the relationship between the time span spent performing the project and the "tasking horizon" is represented by the equation  $X = kY$ , wherein  $X$  represents the time span spent performing the project,  $Y$  represents the fixed amount of time encompassed by each "tasking horizon," and  $k$  is a coefficient representing the number of tasking horizons in the project time span.

The Examiner's interpretation of "tasking horizon" as set forth on page 15 in the Examiner's Answer, i.e. "planned end of task date" and/or "planned task completion date," does not comport with the concept of a "tasking horizon" in accordance with Appellant's invention. The "definitions" adopted by the Examiner are dates, not a length of time. Moreover, the Examiner's definitions correspond with the estimated or predicted task dates recorded by the worker performing the relevant task.

The Examiner appears to base his "interpretation" of the term "tasking horizon" on the passage cited from page 8 of Appellant's specification, i.e., "the farthest point in time in the future where a manager believes a task will be completed as planned." Although awkwardly stated, this passage does not "define" a "tasking horizon" to be a task related date, as does the Examiner's definition. Rather, this passage represents that the length of time encompassed by a tasking horizon should be determined by the furthest point in time from the present time within which the manager would expect the project workers to be able accurately estimate how their time will be spent with respect to their assigned tasks. (Beyond that point in time, it would be too difficult to predict how one's time will be spent.) This concept is supported by the context of all of the other passages of the specification relating to or in which "tasking horizon" is mentioned.

## 2. Verbs

Appellant's specification describes the term "verbs" as representing a set of words and/or phrases which are prepared during the planning stages of the project, and associated with the project and/or tasks within the project. (e.g., specification p. 6, lns. 13-22, and p. 12, ln. 22 – p. 13, ln. 13, Fig. 4). The predetermined "verbs" generally include a list of reasons or explanations, wherein each worker will select a "verb" from this predetermined list and associate it with every actual task date that he or she records.

The Examiner's "definition" of the term "verbs" as set forth on page 15 of the Examiner's Answer is incorrect because it does not capture the concept of a predefined list of words or phrases associated with the project and/or its tasks. Rather, the Examiner's "definition" is nothing more than a general status report with no suggestion of any type of detail or structure whatsoever.

Page 16 of the Examiner's Answer asserts that "Duncan discloses a Glossary of terms (see pg. 157) that may be used with the Duncan invention and that encompasses presenting verbs (and other terms) used during the various stages of an activity or project." This Glossary which "presents verbs" is nothing more than a glossary of relevant terms used throughout the book (Duncan). According to the present invention, the "verbs" associated with a particular project and/or its tasks are specific to the particular project and/or tasks at hand, and are not necessarily applicable for all projects in general, i.e., terms of art, etc. Such words and/or phrases are generally unrelated to the terms of art used in connection with the description and discussion of the topic of project planning and management. Since Duncan's Glossary provides explanations of the terms used in the book for generally instructing the reader on the topic of project management, it is clear that the Glossary does not correlate to the term "verbs" as defined within the context of the claimed invention.

Moreover, the words defined in Duncan's glossary are not words or phrases associated with the specific project at hand and/or tasks thereof, prior to the start of the any work being performed on a particular project, for being selected by a worker as an explanation for each success and/or failure in meeting interim goals. Duncan simply does not disclose any term having a meaning which resembles Appellant's "verbs." Therefore, the "verb" or "verbs" as recited in Appellant's claims are far from being met by Duncan's disclosure.

### 3. Risk Factor

As supported by the description of “risk” in Appellant’s specification (specification, p. 19, ln. 3 – p. 20, ln. 6; p. 22, ln. 19 – p. 23, ln. 10, *inter alia*), the “risk factor” recited in claims 6 and 8 in the present application is computed based on differences between estimated and actual task dates relative to a tasking horizon and selected verbs inputted by the project workers. For example, in Appellant’s claim 6, the risk factor is recited as being computed based on churn data and received verb data. As discussed previously and mentioned below, churn data must be calculated relative to a tasking horizon. As such, the term “churn data,” and also the term “verb data” as discussed previously and mentioned above, represent concepts which are not disclosed or suggested in Duncan. Thus, the risk factors calculated in Appellant’s claimed invention are also not disclosed or suggested in Duncan, as proffered by the Examiner (at Examiner’s Answer, p. 21).

### 4. Churn

From the bottom of page 21 through the first paragraph on page 22, the Examiner’s Answer maintains that the cited passages of Duncan “encompasses Appellant’s claim aspect of computing churn through the aspect of performing variance analysis.” Again, there is absolutely no suggestion in Duncan as to computing a difference between an estimated date and an actual date relative to a predetermined window of time (i.e., a “tasking horizon”), as represented by the term “churn” in Appellant’s invention. The passages of Duncan cited in the Examiner’s Answer merely disclose the general process of variance analysis, which is inherent to the management of all projects. However, Duncan’s discussion of variance analysis, and all the other subject matter disclosed in Duncan fail to suggest the concept of “churn” as specifically defined and calculated in accordance with the claimed invention.

B. THE CITED REFERENCES DO NOT PROVIDE MOTIVATION TO UPDATE THE PROJECT STATUS IN REAL TIME AS RECITED IN APPELLANT'S CLAIMS.

On page 17, the Examiner's Answer contends that Duncan's disclosure of updating the project plan as the project progresses "infers automatically updating the project status in real time." Duncan is entirely silent as to the frequency of the updates. One of ordinary skill in the art reading Duncan would only "infer" updating the project status in real time by impermissibly injecting hindsight knowledge of the claimed invention into Duncan's disclosure.

The Examiner then "supports" his prophetic interpretation of Duncan with Levinson, which teaches a personal planner device. (Examiner's Answer, p. 17-18). Any electronic planning and scheduling device will automatically move, rearrange or update scheduled events in accordance with a user's inputs to the device. Specifically, when a user inputs information into the device, the user's inputs are reflected directly by the schedule of events retained in the device memory. This is like saying that a document is updated in real time as a user types words into the document using a word processing program. While it may be true that the scheduled events entered into Levinson's disclosed device immediately reflects information inputted by the user, Levinson is unconcerned with the effects of the inputted information beyond the recording and arrangement of the scheduled events. Moreover, the scheduled events in Levinson's device each has no impact on any other event except with respect to any time conflict between the events. A delay of one event, barring interference with any other scheduled event, has no consequence on any other event.

Project management, on the other hand, is a complex operation in which the project status is affected by many variable factors, including the performance of each and every task. In the claimed invention, the actual date and verb information inputted



by the project workers are not simply reflected in the arrangement of scheduled dates, but is further transformed and combined with other data to update an overall project status on a real time basis. One of the unique aspects of the claimed invention is that it provides a specific method and apparatus to efficiently and effectively manage a complex project by performing specific steps and acts. Neither Duncan nor Levinson provides any teaching or suggestion as to how the status of a project can be updated in real time, as recited in Appellant's claims.

The Examiner's Answer further presents an argument on page 20 that Duncan discloses updating a project status in real time by accessing information from a look up table. Although the cited passages of Duncan teach the referencing of historical data during the initiating stage of a project (prior to the start of execution of any project related tasks), the Examiner asserts that page 29 in Duncan provides an illustration of various project processes overlapping in time, which equates to updating the project status in real time. This is another example of using improper hindsight to modify a reference. Even if Duncan's project initiation process overlapped any other project process, there is still no teaching or suggestion in Duncan of using the historical data used for the project initiating to update the project status in real time during performance of the project.

#### C. DUNCAN DOES NOT TEACH THE CLAIMED INVENTION

The Examiner's Answer repeatedly alleges that the specific features of Appellant's claimed invention are disclosed by Duncan and/or Levinson because the claim elements are "encompassed" by the general concepts of project management disclosed in Duncan or the personal scheduling device of Levinson. For example, at about the middle of page 18, the Examiner's Answer provides that "Levinson encompasses project planning and scheduling." In another example, the middle

paragraph on page 20 of the Examiner's Answer contends that "Duncan encompasses the time sequence as span as claimed by Appellant."

One of the most basic principles of patent law is that a claim can only be rendered obvious by the cited references "if each and every element as set forth in the claim is found, either expressly or inherently described" in the cited references.

Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). *See also* Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (stating that "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim."). MPEP § 2131.01.

However, when one considers the general fabric of the project management guide disclosed in Duncan next to the general fabric of the project management method and apparatus disclosed and claimed in the present application, it is clear that the two are clearly and irreconcilably distinct from one another. Specifically, Duncan is a generalized outline or guide to be used as a reference for a project manager in managing a project. The claimed invention, however, is an actual method and apparatus for implementing project management, which relies on human input and interaction with a computer software and/or network environment. The level of detail involved with the performance and operation of the claimed invention is simply not contemplated in the overview guide disclosed in Duncan.

All project management processes, plans, etc. share the same goals of cost efficiency, time efficiency, and effectiveness in the planning, scheduling, and execution of the project, from start to finish. Such broad goals, however, are not a teaching or even suggestive of the specific features of Appellant's claimed invention.

Levinson's planning and scheduling device is even further from the project management process and apparatus disclosed and claimed in the present application.

As mentioned above, the scheduled events in Levinson's device each has no impact on any other event except with respect to any time conflict between the events. In the claimed invention, the project status is affected by the performance of each and every task within the project. Thus, Levinson fails to provide any suggestion or motivation for planning, managing and monitoring a project as claimed in the present application.

Neither Duncan nor Levinson provides any disclosure which would inspire one of ordinary skill in the art to develop a project management method and apparatus having the specific details and features recited in Appellants' claims.

## II. CONCLUSION

For all of the reasons discussed in this Reply Brief, Appellants respectfully submit that the final rejection of obviousness over Duncan and Levinson is untenable, and that the present invention as recited in claims 1, 6-8 and 10-33 are allowable. Accordingly, reversal of the rejection under 35 U.S.C. 103 is courteously solicited.

Dated: March 15, 2004

Respectfully submitted,

By 

Jon D. Grossman

Registration No.: 32,699

Ellen S. Tao

Registration No.: 43,383

DICKSTEIN SHAPIRO MORIN &  
OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorneys for Applicant